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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,017	12/21/2001	Yeh-Hung Lai	83648MGB	5674
7590	12/02/2004		EXAMINER	
Thomas H. Close Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201				PRONE, JASON D
				ART UNIT PAPER NUMBER
				3724
DATE MAILED: 12/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/037,017	LAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason Prone	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 August 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-11 and 15-28 is/are pending in the application.  
4a) Of the above claim(s) 2,4,6,9 and 19-28 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3,5,7,8 and 10-18 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 09 August 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5, 7, 8, 10, 11, 17, and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 9, and 10 of U.S. Patent No. 6,820,784. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3, 5, 9, and 10 of 6,820,784 anticipate the same structure of the invention as claimed. However,

6,820,784 does not disclose that the first cutter moves perpendicular to the sheet material and that further propagating the crack with the rake edge of the cutter base disengages the first crack initiator from the sheet material. From the structure set forth in 6,820,784, moving the first cutter perpendicular to the sheet material and further propagating the crack with the rake edge thereby disengaging the first crack initiator from the sheet material is inherent.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action.

A person shall be entitled to a patent unless -

(f) He did not himself invent the subject matter sought to be patented.

4. Claims 1-3, 5, 7, 8, 10, 11, 17, and 18 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is not clear who actually invented the subject matter of claims 1-3, 5, 7, 8, 10, 11, 17, and 18 because each the instant application and U.S. Patent No. 6,820,784 have different inventive entities. Therefore, it is not clear which portions of the application were invented by the same inventive entity of the instant application.

Keeping in mind that, from the structure set forth in 6,820,784, moving the first cutter perpendicular to the sheet material and further propagating the crack with the rake edge thereby disengaging the first crack initiator from the sheet material is inherent.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7, 8, 10, 11, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fruit.

Fruit discloses the same invention including engaging a first side of the sheet metal with a first crack initiator having a high rake angle (12), that the crack initiator extends from a first cutter base having a low rake angle (10), simultaneously engaging a second side of the sheet material with a second cutter (13), generating a first crack in the first side of the sheet material with the first crack initiator (Fig. 2), engaging the sheet material with the cutter base of the first cutter by moving the first cutter perpendicular to the sheet material (10), further propagating the first crack using a rake edge of the cutter base, thereby disengaging the first crack initiator of the first cutter from contact with the sheet metal (Fig. 2), continuing to propagate the crack through to the second side of the sheet material using a rake edge of the cutter base (Fig. 2), generating a second crack in the second side of the sheet material with the second cutter (Fig. 2), that the first and second cracks intersect (Fig. 2), that the high rake angle of the first crack initiator is in the range of from about 45°-to about 70° (12), that the crack initiator has a relief angle greater than 0° and not more than about 30° (12), and that the cutter base of the first cutter has a relief angle of not more than 30° (10).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fruit in view of Camp et al. Fruit discloses the invention including that the first crack initiator has a height and is at least 20  $\mu\text{m}$  (12) but fails to disclose that the height is greater than a thickness of a protective coating on the first side of the laminated web structure. Camp et al teaches that the height is greater than a thickness of a protective coating on the first side of the laminated web structure (25). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Fruit with a first crack initiator that has a height greater than a thickness of a protective coating, as taught by Camp et al., to allow the crack initiator to penetrate through a coating as well as the sheet material.

***Response to Arguments***

9. Applicant's arguments filed 09 August 2004 have been fully considered but they are not persuasive. Fruit clearly teaches cutting a sheet material. A metal band is a sheet of metal. The claim does not disclose any specifics in regards to the parameters of a sheet material. In Figure 5, items 12 and 13 pass by one another while the sheet is in-between the two, therefore, 12 and 13 would have to enter the sheet material in order for 10 to start cutting. Also, the claim states that the crack initiator has a height that is at

least 20  $\mu\text{m}$ , therefore, any height that is bigger than 20  $\mu\text{m}$  reads on the claim. In this case, item 12 is clearly bigger than 20  $\mu\text{m}$ .

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. LI et al., Lai et al. ('376), Lai et al. ('760), Gao et al., and Van Dalen et al.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP  
November 23, 2004

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700